

REMARKS

This amendment responds to the office action mailed February 25, 2009. In the office action the Examiner:

- rejected claims 20-22 under 35 U.S.C. 101 as being directed to non-statutory subject matter;
- objected to claims 17, 19, 21, 34 and 36 under 37 C.F.R. 1.75(c) as being improper dependent form;
- rejected claims 15-22 and 32-37 under 35 U.S.C. 112, first paragraph; and
- rejected claims 15-22 and 32-37 under 35 U.S.C. 103(a) as being unpatentable over Moody et al. (U.S. 2005/0144157) in view of Baldonado (US 7,035,903).

Office Actions in Related Applications

The pending application may be related to US Patent Application serial number 10/816,428. An office action on that application was mailed June 26, 2008 and a response was filed October 27, 2008. The pending application is also related to US Patent Application serial number 10/914,034. An office action on that application was mailed April 22, 2008 and a response was filed July 22, 2008. The Examiner is encouraged to review the art made of record, the Office Action and the response in the above-mentioned related applications.

CHANGES TO CLAIMS

Independent claims 15, 20, 32 and 37 have been amended, support for which can be found in at least paragraphs [0048]-[0050], [0098] and [0143] and Figure 19 of the application as filed. A “wherein” phrase of these claims has been moved to new claims 41-44.

Claims 17, 21 and 34 have been amended to recite that the single item representing a respective conversation includes a list of sender identifiers corresponding to senders who have sent messages in the conversation. Support for the amendments to claims 17, 21 and 34 can be found in at least paragraph [0048] of the specification as filed.

Claims 18 and 35 have been amended to recite that the list of sender identifiers are ordered according to their respective message arrival time. Support for the amendments to claims 18 and 35 can be found in at least paragraph [0048] of the specification as filed.

Claims 19 and 36 have been amended to recite that at least one sender identifier is represented by an icon or unique character string distinct from names of the senders. Support for the amendments to claims 19 and 36 can be found in at least paragraph [0050] of the specification as filed.

New claims 41-44 contain a “wherein” phrase formerly included in their respective parent claims 15, 20, 32 and 37.

With respect to all amendments, the Applicant has not dedicated or abandoned any unclaimed subject matter. Moreover, the Applicant has not acquiesced to any characterizations of the invention, nor any rejections or objections of the claims, made by the Examiner.

After entry of this amendment, the pending claims are: claims 15-22, 32-37 and 41-44.

REJECTIONS UNDER 35 U.S.C. 101

The amendment to claim 20 is believed to address the rejection under 35 U.S.C. §101. As revised, claims 20-22 are directed to patentable subject matter, and is supported by at least paragraph [0143] and Figure 19 of the specification.

CLAIM OBJECTIONS

Claim 17, 19, 21, 34 and 36 have been rejected under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claims.

The amendments to claims 17, 19, 21, 34 and 36 is believed to address the claim objections. Accordingly, removal of this objection is respectfully requested.

REJECTIONS UNDER 35 U.S.C. 112

Claims 15, 20, 32 and 37 have been amended to recite “in-reply-to,” support for which can be found in paragraph [0098] of the specification. Accordingly, removal of this objection is respectfully requested.

REJECTION UNDER 35 U.S.C. 103(a)

Claims 15-22 and 32-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moody in view of Baldonado. “All words in a claim must be considered in judging the patentability of that claim against the prior art.” MPEP §2143.03 citing *In re Wilson*, 424

F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

1. *Neither Moody nor Baldonado discloses or suggests a presentation of a plurality of conversations, each conversation being represented as a single item in a list of conversations.*

As amended, claim 15 states, in part:

as a search result to the search query, returning to the client for display, a list of the identified conversations, each conversation in the list being represented as a single item in the list of conversations, at least one of the conversations in the list comprising two or more electronic messages from distinct senders.
(Emphasis added).

Although Moody discloses the feature of allowing the user to search for messages that include search terms and all related messages, it does not teach or suggest that the search results includes a list of conversations. Moody also teaches displaying an initial message that matches a search query while hiding any related messages from the user. A user can expand the initial message to view the other related messages. (*Moody*, paragraphs [0059] and [0060]). In fact, Figure 2 is the only screenshot of Moody that illustrates how the email messages are displayed to an end user; none of the other screenshots (Figure 3-5) in Moody illustrate how email messages are displayed. Thus, the only email message display format taught by Moody is one message per line.

In contrast, claim 15 recites a presentation of a list of conversations, each conversation being represented as a single item, and each having a respective conversation identifier. Each listed conversation has one or more messages, and at least one of the listed conversations includes a two or more electronic messages from distinct senders. Thus, even a single-message conversation of the present application is different from a message that occupies one line in Figure 2 of Moody because the conversation is associated with a conversation identifier.

Baldonado displays incoming messages individually in an order based on their arrival times. (Baldonado, Figure 3). Thus, Baldonado does not teach “each conversation in the list being represented as a single item in the list of conversations.”

In sum, Moody and Baldonado, separately or in combination, fail to teach or suggest at least one claimed feature of claim 15 and its dependent claims. Thus, there is no *prima facie* case of obviousness for independent claim 15 and dependent claims 16-19. Independent claims 20, 32 and 37 and dependent claims 22 and 33-36 are patentable over the combination

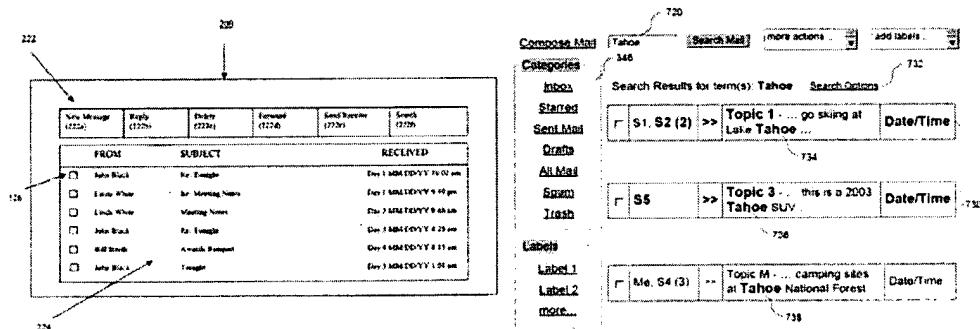
of Moody and Baldonado for analogous reasons as those with respect to claim 15. The Applicants respectfully request that this rejection be withdrawn.

2. *The combination of Moody and Baldonado fails to teach wherein the single item representing a respective conversation includes a list of sender identifiers corresponding to senders who have sent messages in the conversation.*

As amended, claim 17 states, in part:

wherein the single item representing a respective conversation includes a list of sender identifiers corresponding to senders who have sent messages in the conversation.
(Emphasis added).

For illustration, Figure 2 of Moody and Figure 7B of the present application are reproduced below side by side. In Figure 2, the incoming messages are displayed individually in an order based on their arrival times. Because the messages in Moody are displayed one item per line, only the name of the sender of a single message is displayed.



Baldonado also displays incoming messages individually in an order based on their arrival times. (Baldonado, Figure 3) Because the messages in Baldonado are displayed one item per line, only the name of the sender of a single message is displayed.

In contrast, claim 15, which claim 17 depends from, requires that the messages are organized into conversations. Each conversation is displayed as single item on the screen. See, e.g., Figures 6D and 7C of the present application. If a conversation includes messages from two or more senders, a list of sender identifiers who have sent at least one message in the conversation is displayed in the item corresponding to the conversation. For example, Figure 7B above depicts that the first conversation includes senders S1 and S2.

Thus, for at least this reason, the combination of Moody and Baldonado does not teach "wherein the single item representing a respective conversation includes a list of sender identifiers corresponding to senders who have sent messages in the conversation." Therefore,

there is no *prima facie* case of obviousness for dependent claim 17 and associated dependent claims 18 and 19. Dependent claims 21 and 34 and associate dependent claims 22 and 35-36 are patentable over the combination of Moody and Baldonado for analogous reasons as those with respect to claim 17.

CONCLUSION

By responding in the foregoing remarks only to particular positions asserted by the examiner, the Applicant does not necessarily acquiesce in other positions that have not been explicitly addressed. In addition, the Applicant's arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim.

In light of the above amendments and remarks, the Applicant respectfully requests that the Examiner reconsider this application with a view towards allowance. The Examiner is invited to call the undersigned attorney at (650) 843-4000, if a telephone call could help resolve any remaining items.

Respectfully submitted,

Date: May 26, 2009 / Gary S. Williams / 31,066

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